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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,567	09/25/2003	Arthur J. Kover	195-001	4010
7590 08/04/2009				
Steven S Payne 6027 ILIFF Drive Dunn Loring, VA 22027				
EXAMINER				
VAN BRAMER, JOHN W				
ART UNIT		PAPER NUMBER		
3622				
MAIL DATE		DELIVERY MODE		
08/04/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/669,567

**Applicant(s)**

KOVER ET AL.

**Examiner**

JOHN VAN BRAMER

**Art Unit**

3622

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-9 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-9, and 12-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 20, 2009 has been entered.

### ***Response to Amendment***

2. The amendment filed on April 20, 2009 cancelled no claims. Claims 1 and 9 were amended and no new claims were added. Thus the currently pending claims addressed below are Claims 1, 4-9, and 12-16.

### ***Claim Rejections - 35 USC § 101***

3. Claims 1, and 4-8, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-

88 (1876)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the method steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing. The claims are directed towards collecting data and posing a question. Each of these steps could be performed manual and do not require that any specific apparatus is required. A conversation between two individuals could conceivably conduct all of the required steps of the claimed invention and thus no apparatus would be necessary.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4-9, and 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Lesandrini et al. (PGPUB US 2002/0042733 A1).

Claims 1 and 9: Lesandrini discloses a method and system for obtaining web-based advertising research data over a communications system, comprising the steps of:

- a. Collecting user reaction data of at least one user to at least one advertisement displayed on a web site, wherein said user reaction data comprises at least one of point-and click data, and said point and click data is collected from the advertisement being displayed and comprises at least one of location of at least one feature in the advertisement with a greater impact and location of first feature noticed in the advertisement. (Fig. 9; Fig. 11, Paragraphs [0037], [0076] through [0100], [0104], [0224], [0387] through [0402], [0514], and [0518])
- b. Posing at least one question to said at least one user based on said collected user reaction data. (Paragraphs [0076] through [0100] and Paragraphs [0387] through [0402])

Claims 4 and 12: Lesandrini discloses the method and system according to claims 1 and 9, wherein a feature is a word, phrase, object, person, animal, or scene depicted in the advertisement. (Fig. 9; Fig. 11; Paragraphs [0076] through [0100] and Paragraphs [0387] through [0402])

Claims 5 and 13: Lesandrini discloses the method and system according to claims 1 and 9, further comprising the step of: analyzing collected data. (Fig. 9; Fig. 11; Paragraphs [0076] through [0100]; Paragraphs [0343] through [0350]; and Paragraphs [0387] through [0402])

Claims 6 and 14: Lesandrini discloses the method and system according to claims 5

and 13, further comprising the step of: displaying locations of all point-and-click data collected for the advertisement. (Fig. 9; Fig. 11; Paragraphs [0076] through [0100]; Paragraphs [0343] through [0350]; and Paragraphs [0387] through [0402])

Claims 7 and 15: Lesandrini discloses the method and system according to claims 5 and 13, further comprising the steps of: displaying percentage of point-and-click data collected for various sections of the advertisement. (Fig. 9; Fig. 11; Paragraphs [0076] through [0100]; Paragraphs [0343] through [0350]; and Paragraphs [0387] through [0402])

Claims 8 and 16: Lesandrini discloses the method and system according to claims 5 and 13, further comprising the step of: transforming word responses into point-and-click data for display. (Fig. 9; Fig. 11; Paragraphs [0076] through [0100]; Paragraphs [0343] through [0350]; and Paragraphs [0387] through [0402])

### ***Response to Arguments***

6. Applicant's arguments filed April 20, 2009 have been fully considered but they are not persuasive. The applicant argues that Lesandrini et al. does not disclose gathering point and click data from the advertisement being displayed, wherein the point and click data comprises at least one location of at least one feature in the advertisement with a greater impact and location of first feature noticed in the advertisement. However, Lesandrini specifically states in paragraph [0037] that the

user is selecting and advertisement to be viewed. Thus, it is clear that the advertisement requires clicking in order to activate the advertisement. Lesandrini further discloses in paragraph [0094] that users earn points for viewing commercials. Thus it is clear that the clicking of the advertisement for viewing is being collected. Lesandrini further discloses in paragraph [0100] that the user clicks on a color wheel to select a color that they associate with an advertisement and then enter the meaning of the color. Thus it is clear that data is being collected regarding the color the user clicked on and the meaning of said identified color as it relates to the advertisement displayed. Lesandri further discloses tracking click-through data regarding the advertisements displayed in Paragraphs [0514] and [0518]. Thus Lesandrini is collecting user reaction data of at least one advertisement displayed on a website, wherein said user reaction data comprises point and click data collected from an advertisement being displayed. The applicant asserts that Lesandrini does not ask the user to point-and-click **on at least one feature of the advertisement while it is being displayed**. The examiner can find no limitation in the claims that require the user to point-and-click on the actual features of an advertisement while the advertisement is being displayed. Instead the limitation requires collecting data about an advertisement that is or has been displayed. The claim limitations are broad enough to encompass point and click data collected from having previously displayed and advertisement. Thus the use of the color wheel to by tracking user clicks on the follow-up questions falls within the scope of the claims as currently written. Furthermore, the claims are directed toward collecting user reaction data, and posing a question. The claim does

not recite displaying and advertisement, providing a user with the ability to click on an advertisement feature, and transmitting said click data. Since, the type of user reaction data collected falls within a "wherein" clause in the claim, and the method itself claims no requirements directed towards how the data is gathered, the examiner must interpret the wherein clause as a non-limiting regarding the scope of the claim itself (See MPEP 2111.04). The examiner suggest amending the claim language to require the steps of displaying, requesting a user to react to the data by clicking on at least one feature of an advertisement that is being displayed, storing the user reaction data, and then posing a question. Positively reciting these step will require that they be performed and thus impose limiting features to the claims.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN VAN BRAMER whose telephone number is (571)272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John Van Bramer/  
John Van Bramer  
Examiner, Art Unit 3622